

Remarks:

Claims 1, 3, 4, 6, 7, 10-17, 20-23, 26-33, 44, and 45 are pending. Claims 2, 5, 8, 9, 18, 19, 24, 25, and 34-43 have been canceled without prejudice. Applicants preserve their right to present these claims in a further application.

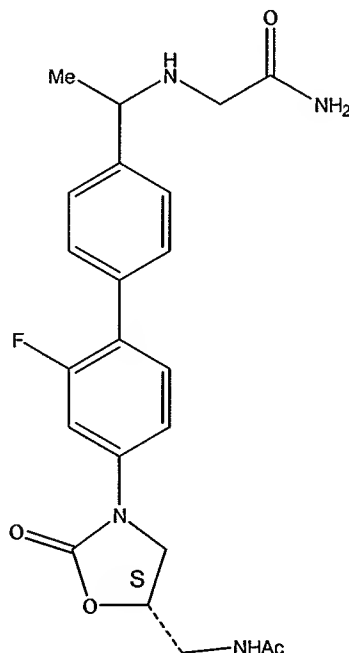
Claim 1 has been amended to recite that R^1 and R^2 are independently selected from F and R^7 and to recite that R^7 is selected from H and C_{1-6} alkyl. The claim has also been amended to remove the remaining portion of the proviso in that it is no longer necessary because it recited compounds in which "B" is pyridyl, which have been deleted from the claims.

Applicants believe that no new matter is added by the amendments.

Election/Restrictions

The Office Action acknowledged Applicants' election without traverse of Group I and compound 101 in the reply of March 7, 2008. The Office Action states

The elected species appeared to be allowable. Thus, the search and examination was extended to non-elected species of



to determine patentability of the generic claims encompassing Applicant's election. The non-elected species is anticipated by the prior art (Section 10). The following subgenus

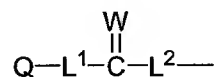
of compounds were further evaluated: Q = -NR₄R₄; L₁ = bond or unsubstituted alkyl; W = O; L₂ = alkyl optional substituted with R₄; X = -NR₄; R₃ = NR₇COR₇; L, R₁, R₂ as defined in claim 1. Multiple species within this subgenus were not allowable under 35 USC 112 1st paragraph (see Sections 8 and 9).

Based on the non-allowability of the generic claims, all non-elected species are currently held withdrawn from consideration.

Applicants respectfully request the Examiner to reconsider the withdrawal and to rejoin the non-elected species, because (1) Applicants will demonstrate that the non-elected species are not anticipated by the prior art (see Applicants discussion below regarding the rejection under 35 USC § 102), and (2) Applicants will demonstrate the allowability of multiple species within the subgenus under 35 USC 112 1st paragraph (see Applicants discussion regarding the rejection under 35 USC 112 below).

Priority

Applicants note that the Office Action essentially states that “[t]he Markush group of claim 1 is not supported by the disclosure in either filed application. Therefore, the priority date of claim 1 is the filing date of PCT/US04/24334 (July 28, 2008).” Applicants traverse the statement. However, Applicants first respectfully point out that the Office Action contains an apparent typographical error, because the PCT international filing date of PCT/US04/24334 is July 28, 2004 and not 2008 as indicated in the Office Action. However, notwithstanding this apparent typographical error, Applicant submit that the disclosure of the prior filed application (Serial No. 60/490,855) provides adequate support as required by 35 U.S.C. 112. Specifically, Applicant points out that most of the elements of claim 1 have their basis in the original provisional application 60/490,855, filed July 29, 2003. Claim 1 of the present application essentially encompasses the Markush elements from the provisional application (*See*, pages 10-19 of the ‘855 application), the main difference being that the presently claimed subgeneric structural element M having the formula:



is now specifically recited in the specification and is claimed. Applicants point out that as-amended W is required to be O in the structural element M.

Information Disclosure Statement

Applicants noted that the information disclosure statements of August 29, 2006 and August 31, 2007 were considered and noted the signed copies of form 1449 enclosed.

Claim Objections

Applicants point out that the objection to claims 1, 3, 4, 6, 10, 11, 13-17, 26, 27, 30, 32, 33, 44, and 45 for containing non-elected subject matter is moot in view of Applicants' arguments in this paper.

Rejection under 35 USC § 112

Written Description

Claims 1, 3, 4, 6, 10, 11, 13-17, 26, 27, 30, 32, 33, 44, and 45 have been rejected under 35 USC 112 1st paragraph as failing to comply with the written description requirement.

Applicants respectfully traverse the rejection and point out that the specification discloses numerous examples of compounds spanning the claimed Markush variables. However, in order to facilitate the prosecution of the application, Claim 1 has been amended to recite the specific substituents now included for R¹, R², and R⁷. The amendments to these variables R¹, R², and R⁷ reflect the compounds reduced to practice as noted by the Examiner on page 7 of the Office Action. Accordingly, Applicants assert that the claims as-amended comply with the written description requirement. Applicants preserve their right to pursue the deleted elements in a further patent application. Based on the amendment to claim 1, it is respectfully submitted that the rejection has been overcome and withdrawal of the rejection is requested.

Enablement

Claims 1, 3, 4, 6, 10, 11, 13-17, 26, 27, 30, 32, 33, 44, and 45 have been rejected under 35 USC 112 1st paragraph. Applicants traverse. On pages 8-9 of the Office Action, the Examiner states that “[t]he specification is enabling for the use of the compounds that have adequate written description.” Applicants assert that as discussed above the claims as-amended comply with the written description requirement and as such, withdrawal of the rejection is requested.

Rejection under 35 USC § 102

Claims 1, 3, 4, 6, 10, 11, 13-17, 26, 27, 30, 33, 44, and 45 have been rejected under 35 USC § 102(e) as being anticipated by Wu et al. (caplus an 2005:12096: priority date June 2, 2004). The Office Action States:

The reference teaches the compound show in Section 3.

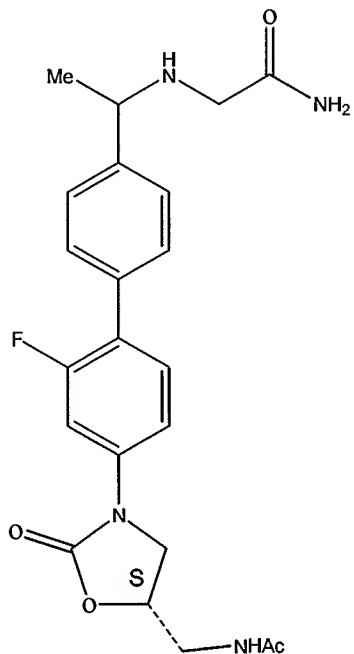
The applied reference has a common inventors [sic] with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 USC 102 (e). This rejection under 35 USC 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

Applicants respectfully traverse the rejection. Notwithstanding that the present application and the cited art reference, Wu et al., are commonly owned by Applicants and share a common inventor, Wu et al. does not constitute prior art under 35 USC 102(e) for the following reason.

Applicants submit that the 102(e) date of the present application is July 29, 2003, which is the filing date of U.S. Serial No. 60/490,855 of which benefit is properly sought. Applicants submit that the claimed subject matter, as-amended, is adequately disclosed in the ‘855 provisional application in compliance with 35 U.S.C. 112, first paragraph as discussed in detail above under the heading “Priority.” As such, Applicant asserts that the present application is

entitled to the earlier filing date under 102(e) of July 29, 2003, which therefore overcomes the 102(e) date of June 2, 2004 of Wu.

Further, Wu et al. is cited for its disclosure of the following compound



However, this very *same* compound is compound **108** of the present application and also compound **10** of the provisional application 60/490,855, filed July 29, 2003, to which the present application claims priority. For compound **108**, see Table 1, at page 30 and Example 9, at page 54, line 4 through page 55, line 5 of the present application. For compound **10**, see Table 1 at page 33, the Example at page 40, and claim 27 of the '855 provisional application.¹

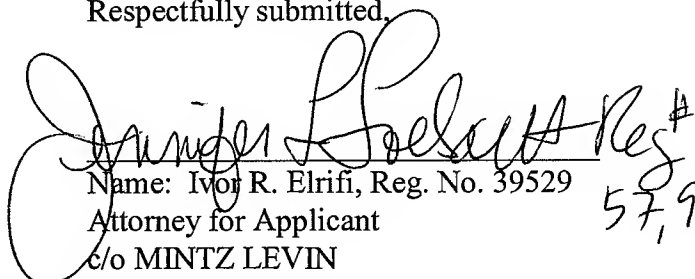
Furthermore, Wu et al. claims priority to the very same '855 provisional application (note that Wu et al. also claims priority to other patent applications, but all of these other priority documents have a later priority date than the '855 provisional application). Said another way, the cited compound has its basis in the very *same* provisional application to which both the present application and Wu et al. claim priority. Therefore, the cited compound cannot anticipate the present application. It is respectfully submitted that the rejection has been overcome.

Conclusion

In summary, based on the foregoing, Applicants respectfully request reconsideration and allowance of claims 1, 3, 4, 6, 7, 10-17, 20-23, 26-33, 44, and 45, as amended.

Respectfully submitted,

Date: October 14, 2008


Name: Ivor R. Elrifi, Reg. No. 39529
Attorney for Applicant
c/o MINTZ LEVIN
Tel: 617-542-6000
Fax: 617-542-2241
Customer Nos. 30623
57,977

4449928v.1

¹ The above structure is as drawn in Wu et al. and in the Office Action. This structure may appear to be different than compounds **108** and **10**, but this apparent difference is merely due to the structures being flipped within the plane of the page and rotated by 90 degrees. The structures depict the very same compound.